

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/713,444

Docket No. 442005-00108

REMARKS

Claims 1-17 and 21-22 are pending in the application. Claims 15 and 21-22 have been withdrawn from consideration as being drawn to non-elected species of the invention. Claims 1 and 6 stand rejected under 35 U.S.C. § 112 ¶1. Claims 1-4, 6-10, 12-14, and 16-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,644,727 to Hanson et al. ("Hanson '727") in view of an examiner's modification. Claims 1, 3, 5-6, 11, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,082,068 to Fisher ("Fisher '068") in view of an examiner's modification.

Amendments to the Specification

The Office has alleged that the specification discloses that "any number of receptacles may be used." Office Action mailed 3/21/2007 at p. 4. The referenced statement is clearly erroneous, in that it the specification discloses a plurality of receptacles spaced a fixed distance from each other, e.g., at heights of 0.75", 1.0", and 1.25" to have a fixed distance of 0.25" from each other, whereas devices having only one or two receptacles per device cannot have such a "fixed distance" between receptacles. Application at p. 7 l. 4 to p. 8 l. 5. The Application has therefore been amended to properly state "... a lesser or greater number of receptacles may be formed..."

Amendments to the Claims

The claims have been amended to recite "partially enclosed receptacles adapted to receive post-tension reinforcement cable after final placement of the chair." Support for this amendment may found in Figs. 1-7, p. 4 ll. 1-3, and p. 10 ll. 11-16 of the Application as filed. Claims 1-11 have been amended to recite receptacles "positioned at different heights, the heights being equally spaced apart heights, from the bottom of the concrete form..." Support for this amendment may be found in p. 8 ll. 3-23 of the Application as filed, as well as the support cited

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for the previous amendment reciting "different and equally spaced apart heights from the bottom of the concrete form." The claims have been amended to recite "[supporting] a post-tension reinforcement cable of a predetermined diameter in an arcuate orientation above the bottom of the concrete form." Support for this amendment may be found in p. 10 ll. 11-16 of the Application as filed.

Rejection of claims 1 and 6 under § 112 ¶1.

Independent claims 1 and 6 stand rejected as failing to comply with the written description requirement of 35 U.S.C. § 112 ¶1. Claims 1 and 6 each required, in part, "at least three receptacles positioned at different and equally spaced apart heights from the bottom of the concrete form..." The Office alleges that "the drawings and specification fail to disclose a chair having receptacles where all of the receptacles are spaced at equal distances from the bottom of the concrete form, as the claim indicates." Office Action mailed 3/21/2007 at p. 3.

The Office's rejection is in error. The conventional manner of parsing language used in the claim limitation excludes a configuration where all the recited receptacles are spaced at equal distances from the bottom of the concrete form since the receptacles must be positioned at different heights from the bottom of the concrete form and at equally spaced apart heights from the bottom of the concrete form. To avoid further delay, the claims under examination have been amended to require "at least three receptacles positioned at different heights, the heights being equally spaced apart heights, from the bottom of the concrete form..." We respectfully note that the Office's current mode of analysis has restated the claim limitation as "all of the receptacles are spaced at equal distances from the bottom of the concrete form." Restating the claim is improper. The recited receptacles must be positioned at different heights, and those different heights must be equally spaced apart heights. See "height," The American Heritage® Dictionary of the English Language, 4th Ed., copyright 2000, Houghton Mifflin Co. ("NOUN: 1. a. abbr. h The distance from the base of something to the top. b. Elevation above a given level, as of the

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sun or a star above the horizon; altitude.") (cited only as evidence of a plain and ordinary meaning). By definition the use of the term "heights" invokes a one dimensional analysis, not the two dimensional analysis used by the Office. We appreciate the Examiner's attempt to examine the claims on the basis of receptacles that are spaced at equal distances from each other, but note that such language may be construed to require at least the first, second, and third receptacles to be provided at the points of an equilateral triangle, i.e., each at an equal distance from each of the others. Such a construction is considerably narrower than the feature that the Applicant has properly claimed.

Rejection of claims 1-4, 6-10, 12-14, and 16-17 under § 103(a) over Hanson '727

Claims 1-4, 6-10, 12-14, and 16-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanson '727 in view of an examiner's modification. The Office argues that Hanson discloses three receptacles, rebutting the Applicant's citation to American Concrete Institute Code 318-05 by stating that "the receptacle is still capable of supporting a reinforcement cable as claimed." Office Action mailed 3/21/2007 at p. 4. The Office also argues that the Applicant discloses that any number of receptacles may be used. *Id.* The cited statement is erroneous in context, and we are not aware of legal authority suggesting that such a statement may be relied upon to prevent the Applicant from narrowing his claims to avoid prior art.

The claims have been amended to recite that the at least three receptacles are partially enclosed and adapted to receive post-tension reinforcement cable after final placement of the chair. We respectfully argue that neither the second nor third receptacles identified by the Office as being present in the Hanson device are adapted to receive post-tension reinforcement cable after final placement of the chair, as the identified second receptacle is fully enclosed after the chair is assembled, and the alleged third receptacle is inherently closed off by the base of the concrete form. The Applicant has disclosed in the specification that the claimed feature solves a stated problem, provides an advantage, and is used for a particular purpose. Application p. 4 ll. 1-3, and

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p. 10 ll. 11-16 (as filed). Therefore the claims are in condition for allowance over Hanson '727.

With regard to the arguments made in the prior rejections, we again argue that the Hanson device is not capable of supporting post-tensioning cable at at least three different heights, so that in applications where support at three heights is necessary the Hanson device must be ordered in multiple sizes, whereas the claimed device need not be. Additionally, the alleged third receptacle does not support post-tensioning reinforcement cable above the bottom of the concrete form as opposed to confining it on the bottom of the concrete form. Moreover, a cable positioned in that manner would not be a post-tensioning reinforcement cable as that term would be interpreted by a person of ordinary skill in the art because a cable placed in the alleged third receptacle would fail to comply with American Concrete Institute Code 318-05 and/or the essentially universal practice of embedding such cable within significant concrete cover, i.e., an effective depth of surrounding concrete. MPEP § 2111 ("The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.") Such an interpretation is confirmed by the fact that Hanson '727 does not even suggest that the alleged third receptacle be used to position a cable abutting the surface of the discussed concrete panels. Hanson '727 is inoperable for the argued use, and the claims presented by the Applicant have distinguished the claimed device from the argued inoperative use by making use of well known and pervasively defined terms of art. MPEP §§ 2144.04, 716.07. Therefore the claims are allowable over Hanson '727.

In addition, the Office admits that Hanson does not disclose that the receptacles are spaced at equally spaced apart heights from the bottom of the concrete form, but argues that it appears to be a matter of obvious design choice to have the at least three receptacles at equally spaced apart heights from the bottom of the concrete and suggests that the Applicant has failed to disclose in the specification that the claimed feature solves a stated problem, provides an advantage, or is used for a particular purpose. *Id.* at pp. 4-5. This requirement is premature and lacks any basis in *Graham*.

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If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use legal precedent as source of rationale supporting a *prima facie* case of obviousness. MPEP §§ 2144, 2144.04. However, the Office has not established such similarity, nor cited to any legal precedent supporting the argued "design choice." Moreover, MPEP 2144.04 forbids the precise argument offered by the Office. "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." MPEP § 2144.04 (citing *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)). Thus the Office has failed to establish a *prima facie* case for obviousness of the claimed invention, and the rejection must be withdrawn.

Moreover, the limitation at issue is "used for particular purposes" that are both inherently and explicitly disclosed in the application. By providing at least three receptacles positioned at different and equally spaced apart heights, knowledge of one height and the spacing interval provides knowledge of all of the other receptacle heights. This is inherently disclosed in the discussion in pages 7-8 of the Application as filed. In addition, by having a plurality of receptacles positioned at different and equally spaced apart heights (described as "a fixed distance" in the discussion) the device enhances the advantage that "once a contractor knows the size or gauge of post-tension reinforcement cable he or she is going to use in a particular concrete form, the contractor is able to order the appropriate number of multi-level chairs 20a having the appropriate size of receptacles," Application at p. 9 ll. 7-11 (as filed), and that "a contractor is able to order a plurality of the same multi-level chair without having to worry about how many of each size to order from a distributor," Application at p. 3 ll. 20-23 (as filed). The Applicant has explicitly stated that such positioning is preferable in achieving that benefit, Application at p. 13 ll. 19 to p. 14 l. 5 (as filed), so that an incremental advantage and particular purpose is disclosed in the application.

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Rejection of claims 1, 3, 5-6, 11, and 20 under § 103(a) over Fisher '068

Claims 1, 3, 5-6, 11, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fisher '068 in view of an examiner's modification. The Office argues that Fisher also discloses three receptacles, implicitly referencing the Applicant's prior argument concerning American Concrete Institute Code 318-05. Office Action mailed 3/21/2007 at p. 9. The Office also argues that the Applicant discloses that any number of receptacles may be used. *Id.* at p. 10. As noted above, this statement is erroneous in context, and we are not aware of legal authority suggesting that such a statement may be relied upon to prevent the Applicant from narrowing his claims to avoid prior art.

The claims have been amended to recite that the at least three receptacles are partially enclosed and adapted to receive post-tension reinforcement cable after final placement of the chair. We respectfully argue that none of the receptacles identified by the Office as being present in the Fisher device are partially enclosed and adapted to receive post-tension reinforcement cable after final placement of the chair, as the identified receptacles are closed loops that are supported by the structure received therein. The Applicant has disclosed in the specification that the claimed feature solves a stated problem, provides an advantage, and is used for a particular purpose. Application p. 4 ll. 1-3, and p. 10 ll. 11-16 (as filed). Therefore the claims are in condition for allowance over Fisher '068.

With regard to the arguments made in the prior rejections, we again argue that the Fisher device is not capable of supporting post-tensioning cable at at least three different heights. In applications where support at three heights is necessary the Fisher device must be ordered in multiple sizes, whereas the claimed device need not be. Moreover, two of the receptacles must be at equal heights abutting the bottom of the concrete form so as to provide a base for the alleged chair. Consequently a cable received in those receptacles would not be a post-tensioning reinforcement cable as that term would be interpreted by a person of ordinary skill in the art

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because that cable would fail to comply with American Concrete Institute Code 318-05 and/or the essentially universal practice of embedding such cable within significant concrete cover, i.e., an effective depth of surrounding concrete. MPEP § 2111 ("The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach."). Therefore the claims are allowable over Fisher '068.

The Office admits that Fisher does not expressly disclose that the receptacles are spaced at equally spaced apart heights from the bottom of a concrete form, but argues that it appears to be a matter of obvious design choice to have the at least three receptacles at equally spaced apart heights from the bottom of the concrete and suggests that the Applicant has failed to disclose in the specification that the claimed feature solves a stated problem, provides an advantage, or is used for a particular purpose. *Id.* at pp. 4-5. This requirement is premature and lacks any basis in *Graham*.

If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use legal precedent as source of rationale supporting a prima facie case of obviousness. MPEP §§ 2144, 2144.04. However, the Office has not established such similarity, nor cited to any legal precedent supporting the argued "design choice." Moreover, MPEP 2144.04 forbids the argument offered by the Office. "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." MPEP § 2144.04 (citing *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)). In view of Fisher's pervasive references to a triangular, V-shaped truss and V-shaped members having brackets disposed at the apex and ends of the two depending legs, e.g., Fisher '068 at col. 4 ll.10-18, Fisher '068 simply and clearly teaches away from the proposed "design choice" so that a bracket may not be "rearranged" into the middle of a leg.

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Again, the limitation at issue is used for particular purposes that are both inherently and explicitly disclosed in the application. By providing at least three receptacles positioned at different and equally spaced apart heights, knowledge of one height and the spacing interval provides knowledge of all of the other receptacle heights. This is inherently disclosed in the discussion in pages 7-8 of the Application as filed. In addition, by having at least three receptacles positioned at different and equally spaced apart heights, the device furthers the goal that "once a contractor knows the size or gauge of post-tension reinforcement cable he or she is going to use in a particular concrete form, the contractor is able to order the appropriate number of multi-level chairs 20a having the appropriate size of receptacles," Application at p. 9 ll. 7-11 (as filed), and that "a contractor is able to order a plurality of the same multi-level chair without having to worry about how many of each size to order from a distributor," Application at p. 3 ll. 20-23 (as filed). The Applicant has stated that such positioning is preferable in achieving that benefit, Application at p. 13 ll. 19 to p. 14 l. 5 (as filed), so that an improvement over alternate positioning is disclosed in the application.

Conclusion

In view of the foregoing amendments and remarks, we respectfully submit that the present claims are allowable over the art of record and pray for a prompt allowance. The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted,

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